

Remarks

Claims 23, 24 and 26-41 are pending in the application. In the Office Action Summary, claims 23, 24 and 26-41 stand rejected. In the Detailed Action, claims 23 and 26-40 were rejected under 35 U.S.C. § 101 as drawn to non-patentable subject matter, and claims 23, 24 and 26-41 were rejected under 35 U.S.C. § 112, first paragraph, for lack of enablement. By this paper, claims 23, 24 and 31-33 have been amended to clarify the claimed subject matter. The Applicants deny that the amendments were not necessitated by the Examiner's rejection or the art of record. No new matter has been introduced by virtue of these amendments. Applicants respectfully request entry of the proposed amendments and reconsideration and allowance of the pending claims in light of the following remarks.

Rejections Under 35 U.S.C. § 101

Claims 23 and 26-40 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Examiner asserts that there is no technological connection in the claims. The Examiner opines that the limitations could be met merely by looking at a table with the "determining" step being accomplished by a person with no technology being used.

The Examiner reiterates that there is no technological innovation or mention of a computer. According to the Examiner, data is not necessarily computer information. The Examiner states that merely receiving data is a trivial use of technology and there is no limitation requiring a computer to actually process the data – the processing would be a requirement for complying with 35 U.S.C. § 101.

Applicants respectfully traverse the Examiner's grounds for rejection. Independent claims 23, 24 and 33 recite processes having useful, concrete and tangible results. Each of these claims recite computer-implemented methods for estimating market value of a used vehicle. A computer is used to implement the receiving data and determining estimated

value steps. Therefore, unamended claims 23, 24 and 33 recite processes within the technological arts, and hence, these claims are drawn to statutory subject matter. For at least this reason, Applicants request the Examiner to remove this rejection.

Although the Applicants do not believe amendments are necessary to overcome this rejection, these claims have been amended to clarify the statutory nature of the claims. As amended, each of independent claims 23, 24 and 33 recite an “electronically receiving data” step and a “electronically determining an estimated value step”, thereby clearly setting forth the use of a computer to execute these steps.

The proposed amendments are supported by the specification. According to Figure 1, data can be received from an historical used vehicle database 12, which is depicted using a common icon for a computer database. Data received from computer database 12 must be received electronically. According to one embodiment of the specification, the determining step includes “[a] computed . . . estimation for the market value of the target vehicle”. (page 11, lines 25-26.)

A person cannot electronically receive data, nor can a person electronically determine an estimated value. In light of the foregoing, Applicants believe that the claims, as amended, are clearly drawn to statutory subject matter under § 101. Therefore, Applicants respectfully request the rejection to be withdrawn.

Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 23 and 26-41 were rejected under 35 U.S.C. § 112, first paragraph as containing subject matter not described in the specification in such a way as to enable one skilled in the art to make or use the invention. However, while the Examiner focuses on the language of the claims as the basis for lack of enablement, the proper inquiry looks to the entire disclosure of an application to determine whether it informs those skilled in the art on how to make and use the invention. *See*, MPEP § 2164.

In the Examiner's Response to Arguments (Pages 4 and 5), the Examiner states as follows:

As to arguments in relation to the rejection under 35 USC 112, 1st paragraph, the examiner understands that the variables represent, however, they are claimed as being arrived at using formulae that are not present in either the specification or the claims and as such, there is no way for one of ordinary skill in the art to make and/or use the invention. For instance, in claim 23, in section B) is the limitation, "...determining an estimated value for the . . . based on the data from the nearest neighbor database, the at least one target used vehicle record, the at least one constraint, and the neighborhood instance function..." There is no way from reading the specification or the claims to know how to determine the estimated value. Questions unanswered in this section are, 'How does the nearest neighbor database affect the price of the vehicle?', 'How does the target used vehicle record affect the price of the vehicle?', 'How does the at least one constraint affect the price of the vehicle?', 'What is the constraint used?', 'How does the neighborhood distance function affect the price of the vehicle?', 'How does one calculate the neighborhood distance function? (Not which variables are used, but how are they combined?)'. As has been discussed in previous actions, the formulae and equations in the specification are not sufficiently described to be useful. Merely stating that there are formulae is not sufficient as these formulae appear to be used to achieve the result and as such, need to be described so that one of ordinary skill in the art could make and/or use the claimed invention. Applicant asserted that claim 33 could be understood using the discussion relating to figures 3 and 4. However, this merely reinforces the examiner's position. The specification merely recites the need for a formula that is not given. Figures 3 and 4 ask the question, "Are there enough neighbors?", there is no answer to this question. How does one ensure that there are enough neighbors? The specification is silent, merely saying that the number must be at least a variable "K" or subsequent calculations would not be accurate. How is "K" calculated? What is the minimum number for "K"?

The Examiner's Remarks raise many questions regarding the enablement of the claims. Applicants respectfully respond that the answers to these questions are found in the

specification. Moreover, in response to the Examiner's assertion that the formulae in certain claims were incomplete, Applicants described how the claims read in light of the specification provided a complete and enabled description of the formulae. (Amendment, June 10, 2003, pages 10-14.)

The Examiner also asserts that the terms "constraint for determining a neighbor relationship," "neighborhood distance function," "determining a distance between a pair of used," and "determining an estimate value based on the data from the nearest neighbor database" are not enabled in this specification. Examples of typical neighbor constraints as provided in the specification are "model, series, and model year." (Application, page 6, lines 17-18.) Neighborhood distance functions are described as "formulas which map or correlate a difference in features or vehicle contents between the pair of vehicles to an amount of used vehicle resale value." (Application, page 8, lines 23-26.) An example of how to use the function to determine distance between a pair of used vehicles is also provided. (Application, page 8, line 26 to page 9, line 12.) Finally, a step of determining an estimate value based on the data would be understood by those skilled in the art as demonstrated in Figure 2 and discussed in the application. (Application, page 9, line 13 to page 11, line 4.)

Regarding claim 31 and 32, the Examiner states that the term "resale plan information" is not enabled. Without acquiescence to this rejection, Applicants have amended the claim to recite "resale information," which is clearly enabled in the specification. (Application, page 7, lines 19-22.)

Regarding claim 33, 35 and 36, the Examiner argues that "from the claims, it would not be possible for one of ordinary skill in the art to know if they were infringing on the claimed invention." However, as previously discussed, when considering enablement, the Examiner must look at the claims in light of the specification. Regarding the variables discussed in these claims, discussion of their meaning and interrelation is found in discussions of Figures 3 and 4, beginning on page 11, line 5 and continuing through to page 13, line 20. Applicants assert that the specification contains sufficient information regarding the subject


matter of the claims as to enable one skilled in the art to make and use the invention without undue experimentation.

CONCLUSION

For the foregoing reasons, Applicants believe that the Office Action of July 8, 2005 has been fully responded to. The present amendments were not earlier presented because the amendments and arguments submitted with the prior amendment addressed all stated rejections in the Office Action. The present amendments and remarks are directed at further illustrating that the Applicants' claimed nearest neighbor feature is patentable. The Examiner has already conducted a search on this concept since it was recited in the original claims. Therefore, the present invention does not raise any new issues for search or consideration and does not require any further searching by the Examiner. As such, Applicants submit that the amendment is appropriate for entry, and that the claims are in a condition for allowance. If the Examiner believes that a telephone conference will advance prosecution of this application, the Examiner is highly encouraged to telephone Applicants' attorney at the number given below.

The Commissioner is hereby authorized to charge any fees associated with the filing of this paper to Deposit Account 06-1510 (Ford Global Technologies, Inc.)

Respectfully submitted,
JIE CHENG ET AL.

By 
Matthew M. Jakubowski
Reg. No. 44,801
Attorney for Applicants

Date: September 21, 2005

BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075-1238
Phone: 248-358-4400
Fax: 248-358-3351